

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

**M. VIKRAM RAO**

Serial No.: **10/631,954**

Filed: **JULY 30, 2003**

Title: **"IMPROVED PARTICULATES AND  
METHODS OF UTILIZING THESE  
PARTICULATES IN SUBTERRANEAN  
APPLICATIONS"**

§  
§  
§  
§  
§  
§  
§  
§  
§

Group Art Unit: **1773**

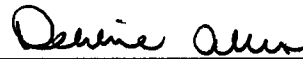
Examiner: **LE, HOA T.**

Atty. Docket No: **2003-IP-010829U1**

**CERTIFICATE OF FILING ELECTRONICALLY VIA EFS  
MPEP 503**

I HEREBY CERTIFY THAT I HAVE A REASONABLE BASIS FOR BELIEF  
THAT THIS CORRESPONDENCE IS BEING SUBMITTED TO THE UNITED  
STATES PATENT AND TRADEMARK OFFICE VIA EFS  
(ELECTRONICALLY) ON THE DATE INDICATED BELOW, AND IS  
ADDRESSED TO:

MAIL STOP APPEAL BRIEF – PATENTS  
HONORABLE COMMISSIONER FOR PATENTS  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450



DEBBIE ALLEN

DATE OF SUBMISSION:  
ELECTRONIC FILING (EFS): **APRIL 17, 2008**

**MAIL STOP APPEAL BRIEF – PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF**

Appellant submits this response to the Notification of Non-Compliant Appeal Brief mailed on March 17, 2008 ("the Notification"). The Notification set a deadline for response for the longer of one month or thirty days from the mailing date of the Notification. As this response is being submitted within one month of the mailing date of the Notification, this response is timely filed.

**I. GENERAL REMARKS**

The Notification states that Appellant's Appeal Brief of January 10, 2007 ("the Appeal Brief") is not in compliance with 37 CFR § 41.37(c). Specifically, the Notification states:

The Appeal Brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claims argued separately, every means plus functions and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with references to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

(Notification at page 2 (emphasis in original)). The Notification further states that “when the Appeal Brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), as in this case, an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice.” *Id.* at page 3 (emphasis in original).

In response to this requirement, Appellant provides the Summary of the Claimed Subject Matter in Section II. below in compliance with 37 CFR 41.37(c)(1)(v), and respectfully request that the Board of Patent Appeals and Interference consider this submission along with Appellant’s original Appeal Brief and reply brief submitted in this matter.

## **II. SUMMARY OF THE CLAIMED SUBJECT MATTER**

Appellant’s invention relates to improved particulates suitable for use in subterranean applications. More particularly, the present invention relates to reduced specific gravity particulates that comprise a substantially spherical shape.

Certain embodiments of Appellant’s invention provide particulates comprising silica, an aluminum oxide in an amount of less than about 25%, and at least one void, wherein the particulates have a specific gravity of less than about 2.2, a particle size of 8 U.S. Mesh or smaller, and a substantially spherical shape (*See* claim 1; *see e.g.*, Specification at page 4, lines 5-9; *id.* at page 5, lines 20-23; *id.* at page 6, lines 18-20; *id.* at page 7, lines 21-28.) In certain embodiments, the particulates may further comprise calcium oxides. (*See* claim 4; *see e.g.*, Specification at page 5, lines 8-11.) In some embodiments, such particulates may have a particle size of 25 U.S. Mesh or smaller. (*See* claim 6.) In certain embodiments, the particulate may further comprise a vitrified outer layer. (*See* claim 8; *see e.g.*, Specification at page 10, lines 1-3.)

Other embodiments of Appellant's invention provide particulates comprising at least about 30% silica, less than about 25% aluminum oxides, a plurality of internal voids, and a substantially spherical shape. (*See* claim 10; *see e.g.*, Specification at page 4, lines 5-12; *id.* at page 5, lines 7-9.) In certain embodiments, the particulates may further comprise calcium oxides. (*See* claim 13; *see e.g.*, Specification at page 5, lines 8-11.) In some embodiments, such particulates may have a particle size of 25 U.S. Mesh or smaller. (*See* claim 15.) In certain embodiments, the particulate may further comprise a vitrified outer layer. (*See* claim 17; *see e.g.*, Specification at page 10, lines 1-3.)

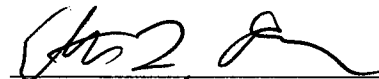
None of Appellant's claims involved in this appeal include any means plus function or step plus function under 35 U.S.C. 112, sixth paragraph.

### III. SUMMARY

In light of the foregoing, Appellant respectfully requests that the final rejection of the pending claims should be reversed and the application be remanded for allowance of the pending claims, or, alternatively, remand the application for further examination if appropriate references can be found by the Examiner.

Appellant believes that no fees are due in association with this filing. However, should the Commissioner deem that any additional fees are due, including any fees for extensions of time, the Commissioner is authorized to debit Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.0285.

Respectfully submitted,



---

Elizabeth L. Durham  
Registration No. 59,509  
BAKER BOTTS L.L.P.  
One Shell Plaza  
910 Louisiana  
Houston, TX 77002  
Telephone: 713.229.2104  
Facsimile: 713.229.7704  
Email: liz.durham@bakerbotts.com

Date: April 17, 2008